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9629 7590 02/18/2010 MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004				
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LOW, LINDSAY M				
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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/564,761
Filing Date: January 17, 2006
Appellant(s): OGAWA ET AL.

Arthur M. Antonelli
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed November 30th, 2009 appealing from the Office action mailed July 8th, 2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

JP 2002337066

KUBO et al

11-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1 and 3-7 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter

which applicant regards as the invention. Regarding claim 1, it is unclear which portion of the contact nose is the "circular cylindrical bore," as the claim recites the bore as being at the upper portion of the contact nose and being uniform in cross section, yet it extends from an interior of the contact nose to an upper end surface transverse to a longitudinal axis. It is unclear how a portion of the contact nose (the circular cylindrical bore) can extend from an *interior* of the contact nose.

Claims 1 and 3-21 stand rejected under 35 U.S.C. 102(b) as being anticipated by Kubo (JP-A-2002-337066, which corresponds to US Patent Number 6,578,750).

Kubo discloses the same invention including a driving cylinder 22, a driving piston 24, a driver 23, a nose body 26 having a lower end with a nail discharge port 25, and a contact nose 34. The contact nose 34 is urged towards a leading end of the nose body. The contact body 34 has an upper end and a leading end (designated below). A cylindrical portion is formed at the contact body's upper portion and defines a circular cylindrical bore (designated below) having a longitudinal axis and a substantially uniform cross section (designated below) transverse to the axis. The nose body is housed in the circular cylindrical bore and the contact nose 34 is slidable along the nail discharge port as can be seen in Fig. 1. The contact nose 34 has a leading end discharge port, which includes a guide portion 36. Note that Kubo's device is capable of driving a nail that is shorter than the length of the guide portion.

Regarding claims 3, 9, and 10, the guide portion has a straight portion 36 and a tapered guide face formed above the straight guide portion and having an inner

diameter gradually increasing upwards (see Fig. 6 and designated below). A nail to be drive is positioned within the straight portion.

Regarding claim 4, the guide portion has a first tapered guide portion formed at the leading end discharge port, and a second tapered guide portion formed above the first tapered guide portion and having an inner diameter that is gradually increasing upwards (designated below).

Regarding claims 5 and 11, a trigger 33 activates the piston.

Regarding claims 6 and 12, the contact nose 34 is movable relative to the nose body (col. 5 lines 11-12) such that the nose body blocks movement of the contact nose so that the trigger is actuated (see Fig. 6).

Regarding claims 7 and 15, the piston is driven by compressed air (col. 4 line 60).

Regarding claim 8, the piston is operable between two positions (the top of the cylinder as shown in Fig. 1, and the bottom of the cylinder when driving a nail). The driver 23 has one end connected to the piston and another end having a first outer dimension transverse to the axis. The nose body 26 has a third end between the driving cylinder and a fourth end and has a first passage extending from the third end to the fourth end (see designations below). The passage defines a first inner dimension that is greater than the first outer dimension (shown in Fig. 1 because the driver reciprocates within a portion of the nose body). The fourth end is received in the contact nose. A nail supply mechanism 28 is disposed between the driving cylinder and the fourth end of the nose body.

Regarding claims 13 and 14, a grip 20 is connected to the driving cylinder. It has a chamber 31 for storing compressed air.

Regarding claims 17-20, the fourth end of the nose body is received in a first circular cylindrical bore, as can be seen in Fig. 1. The first bore has a first diameter. A second circular cylindrical bore (straight guide portion) has a second diameter that is smaller than the first diameter. The second bore is part of the guide portion.

Regarding claim 21, note that the nose body is slidable relative to the hollow member along an axis. The inner surface of the hollow member is substantially perpendicular to the axis as shown below.

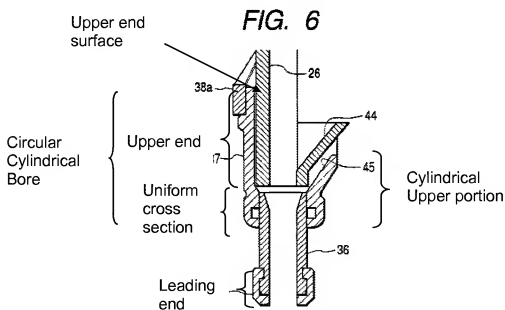
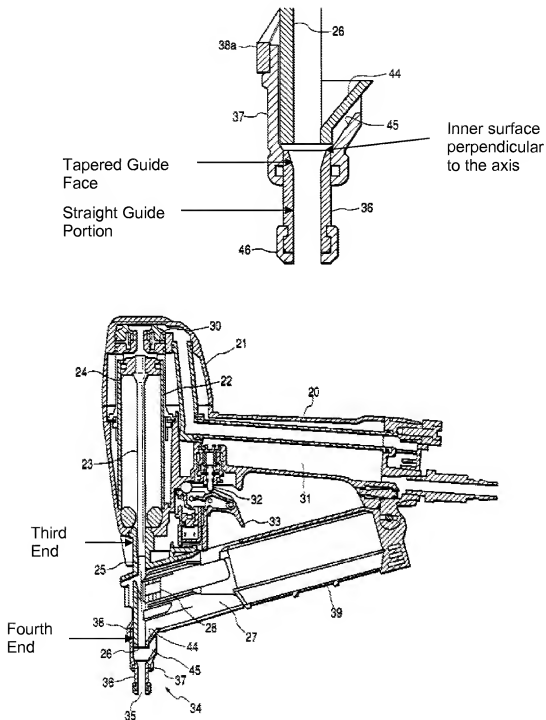


FIG. 6



(10) Response to Argument

Appellant argues that Figure 2 in Appellant's drawings clearly shows cylindrical area 13a extending from an interior of the contact nose. However, the phrase "extending from an interior of the contact nose" is unclear because it is difficult to discern what is meant by an interior. Referring to Appellant's Figure 2, the contact nose 13 has a cylindrical area 13a that extends upwards from the straight guide portion of the contact nose. It is unclear how the cylindrical area is extending from an *interior* of the contact nose. In fact, it appears that no element is extending from an interior of the contact nose.

Appellant argues that Kubo's designated circular cylindrical bore does not have a uniform cross section and instead defines an interior space having no circular cross sectional shape. In Figure 5 of Kubo, a cross section of a top view of the contact nose is shown. Appellant argues that the guide grooves 43 and the escape opening 45 prevent the contact nose from having the circular cylindrical shape. However, as shown in the figures above, the "circular cylindrical bore" designated by the examiner is certainly circular, as it defines a round closed loop portion (especially where it is a uniform cross section). Note that an object can still be "circular" even if it does not form an absolute perfect circle. In addition, the "cylindrical bore" is certainly a "cylindrical" shape, as it has a length in a circular body. The designated bore is also deemed to have a uniform cross section. The portion designated in the figure above clearly shows a uniform cross section of the bore (inside surface).

Appellant argues that the "upper end" designated by the examiner is an unduly broad interpretation. However it should be noted that the claims do not restrict the end of the contact nose to be a specific length or surface. The claims only recite "an upper end" and "a leading end." The "upper end" designated by the examiner is deemed to be an upper end, as it is the uppermost section of the contact nose.

Appellant argues that the nose body is not circumferentially received in the proximal end of the hollow member (contact nose) because that portion of the contact nose is C-shaped and therefore cannot circumferentially surround the nose body. However, it should be noted that Kubo's nose body 26 is certainly received in the proximal portion of the hollow member as shown in Fig. 6. In addition, the nose body is circumferentially surrounded, especially at the position shown in Fig. 6.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Lindsay M Low/
Examiner, Art Unit 3721

Conferees:
/Henry Yuen/
Special Programs Examiner, TC 3700

/Rinaldi I Rada/
Supervisory Patent Examiner, Art Unit 3721